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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,521	06/24/2003	David Edwin Thurston	065435-9027	2183

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EXAMINER

EPPERSON, JON D

ART UNIT	PAPER NUMBER
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1639

MAIL DATE	DELIVERY MODE
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03/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/602,521	Applicant(s) THURSTON ET AL.	
	Examiner Jon D. Epperson	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-49 and 51-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-49 and 51-64 is/are rejected.
- 7) ☒ Claim(s) 39,40,51-58 and 61-63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/21/07</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of the Application

1. The Response filed December 21, 2007 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Status of the Claims

3. Claims 39-64 were pending. Claim 50 was canceled and claims 39, 51-58, 61-64 were amended. Therefore, claims 39-49 and 51-64 are currently pending and examined on the merits.

Withdrawn Objections/Rejections

4. The objection to claim 39 is withdrawn in view of Applicants' amendment thereto. The 35 USC § 112, second paragraph rejections denoted "A-D" are withdrawn in view of Applicants' amendments to claims 39, 51-58, and 61-64 and arguments set forth in the 2nd paragraph section of the 12/21/07 response. The "written description" rejection under 35 USC § 112, first paragraph rejections is withdrawn in view of Applicants' amendments further defining the "T" variable and limiting n, m, q, and to the range defined in the amended claims (i.e., 1 to 16). The Enablement rejection under 35 USC § 112, first paragraph is withdrawn in view of Applicants' amendments to claim 64 adding positive method steps to the claim. The Thurston et al. rejection under 35 USC § 102 is withdrawn in view of Applicants' amendments to the claims limiting the

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“T” variable to an amino acid residue.

New Rejections/Objections

Objections to the Claims

5. Claims 39, 40, 51-58, 61-63 are objected to because of the following informalities:

A. For claims 39, 40, 51-58, 61-63, the use of a comma after the phrases “or an aralkyl group” and “of up to 12 carbon atoms” represent grammatical errors as these phrases should not be separated by commas. Correction is requested.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 51-53, 55-57, and 61-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. For ***claims 51-53, 55-57, and 61-63***, the phrase “if m [or p] is greater than 1” is vague and indefinite in light of the newly added range that requires m/p to be 1-16. Applicants are requested to clarify and/or correct. Therefore, claims 51 and all dependent claims are rejected under 35 U.S.C. 112, second paragraph.

B. A broad range or limitation together with a narrow range or limitation that falls

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within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 64 recites the broad recitation target molecule, and the claim also recites target macromolecule which is the narrower statement of the range/limitation.

Claims Rejections - 35 U.S.C. 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

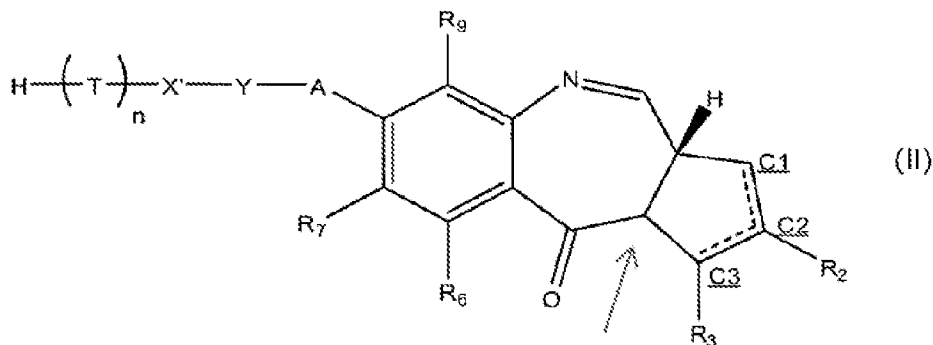
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 39-49 and 51-64 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention. This is a new matter rejection.

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A. Applicants amended claims 39, 51-58, and 61-64 in the 12/21/07 response. In so doing, Applicants removed a ring nitrogen from all of the claimed benzodiazepine structures as indicted, for example, for claim 39 by the red arrow below. This new ring structure represents new matter.

39. (Currently amended) A collection of compounds all of which are represented by formula II:



B. Applicants amended claims 39, 51-58, and 61-64 in the 12/21/07 response. However, support for the $m/p = 1-16$ limitation in claims 51-53, 55-57, and 61-63. The specification only provides the 1-16 range for the n and q variables (e.g., see original claim 15, “ n is from 1 to 16”). Applicants cite page 6, line 14 to page 14, line but these pages merely provide support for n/q greater than 0 (e.g., see page 8, line 15, “ p is a positive integer [not p is 1-16]”). If applicant believes this rejection is in error, applicant must disclose where in the specification support for this amendment can be found in accordance with MPEP §§ 2163.06 and 714.02.

C. In addition, for claim 64, the specification does not provide support for a method step wherein a “target molecule or cell” is contacted with the collection of compounds

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from claim 39. Page 22, line 24 to page 24, line 11 merely provides support for contacting target macromolecules (e.g., see bottom of page 22, “The screening can be carried out by bringing the target macromolecules into contact with individual compounds”).

Conclusion

Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on (571) 272-0763. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jon D. Epperson/
Primary Examiner, AU 1639

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